

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Claims 1-19 are pending in the present application, of which claims 1, 7, 13 and 19 are independent. By virtue of this amendment, claims 8 and 14 have been canceled, and claims 7, 13 and 19 have been amended. No new matter has been added.

Claims 1-18 were rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. Claims 1-6 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,560,639 to Dan et al. ("Dan"). Claims 7-19 were rejected under 35 U.S.C. § 102(e) as allegedly being unpatentable over Dan in view of U.S. Patent No. 6,732,331 to Alexander.

Claim Rejection under 35 U.S.C. § 101

Claims 1-7, 9-13 and 15-18 were rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. These rejections are respectfully traversed because claims -7, 9-13 and 15-18 are directed to statutory subject matter under 35 U.S.C. § 101, and thus, are not required to recite that they are technologically embodied on a computer readable medium.

Claims 1 and 13 are directed to a system, and thus, is directed to statutory subject matter. "If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760." MPEP § 2106 (IV)(B)(2)(a).

Claim 7 is directed to a method. According to the MPEP, for computer related processes to be statutory, “the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10).” MPEP § 2106 (IV)(B)(2)(b). As an example of a statutory process, the MPEP cites:

A computerized method of optimally controlling transfer, storage and retrieval of data between cache and hard disk storage devices such that the most frequently used data is readily available.

Thus, processes that occur within the computer may be statutory, even if the processes are not claimed as technologically embodied on a computer readable medium. In claim 7, the process includes practical applications, including, for example, “retrieving the page from a page storage medium.”

Thus, claims 1-7, 9-13 and 15-18 are directed to statutory subject matter. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 1-18. Insofar as the decisions cited by the Examiner refer to a need for claims to be embodied on a computer readable medium, Applicant points out that these decisions precede at least the *State Street* decision. See, *State Street*, 149 F.3d, 47 USPQ2d (Fed. Cir. 1998). Applicant refers the Examiner to MPEP § 2106 (IV)(B)(2) for a current evaluation of what the U.S. Patent & Trademark Office considers statutory subject matter.

Claim Rejection under 35 U.S.C. § 102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way

to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1-6 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by the disclosure contained in Dan. This rejection is respectfully traversed because the claimed invention as set forth in Claim 1 and the claims that depend therefrom are patentably distinguishable over the disclosure contained in Dan.

It is respectfully submitted that Dan fails to disclose all of the elements set forth in claim 1. For instance, Dan fails to disclose “a tag embedded in each page of a network-based site, each page stored in a page storage medium” or “a script to be called from within the tag,” as recited in claim 1. Dan discloses “a web management system including a database having a directory structure associating each web page of a web site with attributes thereof.” Abstract. In the passages cited by the Examiner, Dan discloses pre-generating web pages and caching them as static pages, where pre-generation includes “a process in which the web management system scans the site’s database 50 for scripts.” Col. 11, lines 25-29. However, Dan does not disclose a tag embedded in each page in any of the passages cited by the Examiner. Further, since Dan does not disclose a tag embedded in each page, Dan does not

disclose a script to be called from within the tag. At least by virtue of the lack of disclosure of these elements, Dan fails to meet the requirements of anticipation as described hereinabove. At least for the reasons set forth above, Claims 1-6 are believed to be allowable over Dan, and the Examiner is respectfully requested to withdraw the rejection of Claims 1-6.

Claim Rejection under 35 U.S.C. § 103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

The Official Action sets forth a rejection of Claims 7, 9-13 and 15-19 under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure contained in Dan in view of Alexander. This rejection is respectfully traversed because Dan considered singly or in combination with Alexander fails to disclose all of the elements of Claims 7, 9-13 and 15-19.

As set forth above, Dan fails to disclose a tag embedded in each page of a network-based site. Thus, Dan fails to disclose the step of "executing a database script associated with

the page through a tag embedded in the page to access configuration information from a configuration database,” as now recited in claims 7 and 19. Similarly, Dan fails to disclose “means for executing a database script associated with the page through a tag embedded in the page to access configuration information from a configuration database,” as now recited in claim 13.

The Official Action does not rely upon the disclosure contained in Alexander to make up for these deficiencies in Dan. Instead, the Official Action asserts that Alexander discloses the steps of receiving a request for a page and retrieving the page from a page storage medium as set forth in claims 7 and 19, and the means to perform such steps. Thus, even if Dan is combined with Alexander, the proposed combination fails to make up for the deficiencies in Dan. At least for the reasons set forth above, Claims 7, 9-13, and 15-19 are believed to be allowable over Dan in view of Alexander, and the Examiner is respectfully requested to withdraw the rejection of Claims 7, 9-13, and 15-19.

PATENT

Atty Docket No.: 10014137-1
App. Ser. No.: 10/052,334

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

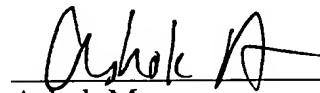
Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

S. Brandon Keller et al.

Dated: February 1, 2005

By



Ashok Mannava

Registration No.: 45, 301

MANNAVA & KANG, P.C.
8221 Old Courthouse Road
Suite 104
Vienna, VA 22182
(703) 652-3822
(703) 880-5270 (fax)